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Patents Department
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In re Application of YU et al
U.S. Application No.: 09/744,788
Int. Application No.: PCT/US99/17116
Int. Filing Date: 28 July 1999
Priority Date: 30 July 1998
Attorney Docket No.: A2996A US
For: ISOFORMS OF HUMAN CALCIUM
SENSING RECEPTOR

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(b) (Filing When an Inventor Cannot Be Reached)" filed 24 January 2002, requesting that the present application be accepted for United States national stage processing without the signature of one of the three joint inventors. The petition is being treated under 37 CFR 1.47(a).

BACKGROUND

On 28 July 1999, applicant filed international application PCT/US99/17116, which claimed priority of an earlier United States application filed 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 February 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 January 2001.

On 30 January 2001, applicant filed national stage papers with the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 14 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 24 January 2002, applicant filed the present petition along with the appropriate extension of time fee and a declaration signed by two of the three joint inventors.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by inventors Kin Yu and Richard Labaudiniere each on his/her own behalf and on behalf of the nonsigning inventor Larry Thrower.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that applicant attempted to contact Mr. Thrower by mail (see affidavit of Andrea Ryan, ¶2). While Ms. Ryan is the person with apparent firsthand knowledge of the correspondence, copies of documentary evidence such as a certified mail return receipt, a cover letter of instructions, or the envelope returned undelivered have not been provided. Furthermore, while applicant has attempted to locate Mr. Thrower through inventor Yu (see Ms. Ryan's affidavit, ¶3, and affidavit of William Coppola, ¶2), no evidence of any attempts to reach Mr. Thrower through inventor Labaudiniere or through Mr. Thrower's friends, family, or other co-workers has been provided. Thus, it cannot be reasonably concluded at the present time that Mr. Thrower cannot be found or reached.

With regard to item (3) above, applicant has provided the requisite petition fee.


With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.


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